

## I. The Office Action

The May 10, 2005 non-final office action (the "Office Action") in this application:

1. rejected claims 28-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent 6,869,610.

2. rejected claim 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5 and 7-12 of U.S. Patent 6,464,986.

3. provisionally rejected claims 28-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 9, 12, 13 and 28-32 of co-pending application 10/630,206.

4. provisionally rejected claims 28-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending application 11/003,677.

5. rejected claims 28-31 under 35 U.S.C. 112, second paragraph, as being indefinite for a lack of essential steps.

6. rejected claims 28-29 and 31 as indefinite because the term "botulinum toxin" was not clear which botulinum toxin or how many botulinum toxins are administered.

7. rejected claim 30 as indefinite because the claim was dependent from a cancelled claim.

8. rejected claims 28-30 under 35 U.S.C. 102(b) as anticipated by Binder (WO 95/30431).

## II. Terminal Disclaimers

### 1. Patent 6,869,610

The Office Action rejected claims 28-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent 6,869,610.

While applicant does not agree that claims 28-31 are unpatentable over claims 1-5 of U.S. Patent 6,869,610 due to obviousness-type double patenting, a terminal disclaimer is enclosed to obviate this rejection and thereby expedite prosecution of this application.

### 2. Patent 6,464,986

The Office Action rejected claims 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5 and 7-12 of U.S. Patent 6,464,986.

While applicant does not agree that claim 31 is unpatentable over claims 1, 3, 5 and 7-12 of U.S. Patent 6,464,986 due to obviousness-type double patenting, a terminal disclaimer is enclosed to obviate this rejection and thereby expedite prosecution of this application.

### 3. Co-Pending Application 10/630,206

The Office Action provisionally rejected claims 28-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 9, 12, 13 and 28-32 of co-pending application 10/630,206.

While applicant does not agree that claims 28-31 are unpatentable over claims 1, 4, 5, 9, 12, 13 and 28-32 of co-pending application 10/630,206 due to obviousness-type double patenting, a terminal disclaimer is enclosed to obviate this rejection and thereby expedite prosecution of this application.

4. Co-Pending Application 11/003,677

The Office Action provisionally rejected claims 28-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending application 11/003,677.

While applicant does not agree that claims 28-31 are unpatentable over claim 1 of co-pending application 11/003,677 due to obviousness-type double patenting, a terminal disclaimer is enclosed to obviate this rejection and thereby expedite prosecution of this application.

Therefore, withdrawal of the rejection is requested.

### III. 35 U.S.C. 112(2) Rejection.

#### 1. Lack of essential steps.

The Office Action rejected claims 28-31 under 35 U.S.C. 112, second paragraph, as being indefinite for a lack of essential steps in the method for treating neuralgia or post-operative pain.

Applicant hereby cancels claims 28-30 without prejudice to further prosecution at a later date.

Applicant has amended claim 31 to add the limitation "a therapeutically effective amount of." This is supported by the specification by at least page 34, line 2-3.

Applicant has also amended claim 31 to add the limitation "thereby alleviating the post-operative incisional wound pain." This is supported by the specification by at least page 44, lines 23-29.

The claims as amended comply with the examiner's suggestion and do not introduce any new matter. Therefore, withdrawal of the rejection is requested.

#### 2. Indefiniteness Rejection.

The Office Action rejected claims 28-29 and 31 as indefinite because the term "botulinum toxin" was not clear which botulinum toxin or how many botulinum toxins are administered.

In Claim 31, Applicant has replaced the term "botulinum toxin" with "a botulinum toxin."

Therefore, withdrawal of the rejection is requested.

3. Indefiniteness Rejection – Improper Dependent Claim

The Office Action rejected claim 30 as indefinite because the claim was dependent from a cancelled claim.

Applicant has cancelled claim 30 without prejudice to further prosecution at a later date.

Therefore, withdrawal of the rejection is requested.

IV. 35 U.S.C. 102 Rejection as Anticipated by Binder (WO 95/30431)

The Office Action rejected claims 28-30 under 35 U.S.C. 102(b) as anticipated by Binder (WO 95/30431).

Applicant has cancelled claims 28-30 without prejudice to further prosecution at a later date.

Therefore, withdrawal of the rejection is requested.

V. Amendment to Page One of the Specification

The title of the application has been amended to provide a title more descriptive of the claimed subject matter.

Thus, applicant has changed the title from: "Neuralgia Pain Treatment by Peripheral Administration of a Neurotoxin"

to: "Post-Operative Pain Treatment by Peripheral Administration of a Neurotoxin."

The amended title is supported by at least page 23, lines 13-20 of the specification.



## VI. New Claims Added

New claims 32-37 have been added.

New claim 32 is supported at least by page 29, lines 5-7 of the specification.

New claim 33 is supported at least by page 29, line 7-9 of the specification.

New claims 34 and 35 are supported at least by page 23, lines 13-20 of the specification.

New claim 36 is supported at least by page 19, line 27 through page 20, line 1 and page 44, lines 27-28 of the specification.

New claim 37 is supported at least by page 40, lines 9-11 and page 44, lines 28-29 of the specification.


New claim 38 is supported by the specification as noted above.

VII. Conclusion

All issues presented by the examiner have been addressed. Examination and allowance of claims 31-38 is requested.

Respectfully submitted,

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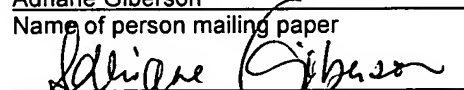
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CERTIFICATE OF EXPRESS MAIL UNDER 37 C.F.R. § 1.10

I hereby certify that this Transmittal Letter, Response to Office Action and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date June 9, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label number **EL980001418US** addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: June 9, 2005

Adriane Giberson  
Name of person mailing paper  
  
Signature of person signing paper